

REMARKS

Favorable reconsideration, reexamination, and allowance of the present patent application are respectfully requested in view of the following remarks.

As discussed during the telephone conversation between the undersigned and Examiner Gangle, the following arguments are presented.

The Notice alleged, on the Continuation Sheet thereof, that the claims as originally filed were drawn to a methanol-utilizing bacterium that contains a gene with the sequence of SEQ ID NO: 1, and that the amended claims filed 08 January 2007 are drawn to a disrupted and non-functional version of the gene having the sequence of SEQ ID NO: 1. The Notice goes on to assert that the disrupted gene is independent from the originally elected invention. Applicant strongly disagrees with the Notice's improper, incomplete, and erroneous restriction requirement, and therefore the issuance of the Notice.

"Election by Original Presentation", as that phrase has become known in U.S. patent practice, occurs when, as described in M.P.E.P. § 821.03 with reference to Form Paragraph 8.04, an Applicant adds a second set of claims after an Office Action in which a first set of claims have been acted upon, and in which the first and second sets of claims are mutually restrictable (under theories of restriction based on statutory class of invention, Election of Species, or another recognized theory). Fundamental to Election by Original Presentation practice is the requirement that the two sets of claims (the original and the new) be properly restrictable as defined in M.P.E.P. § 806 *et seq* and, therefore, the requirement that an Office Action plainly and completely set out the restriction requirement, including the two alleged bases that the claim sets are independent and distinct.

The Notice sweeps aside these requirements by baldly alleging that Claim 7-8 do not read on an 'elected invention' because they recite only a disrupted form of the gene. However, the disrupted form of the gene was encompassed by the original claim 7 in the originally filed application, in that original Claim 7 recited "...wherein a gene on said bacterium's chromosome has the same nucleotide sequence as the DNA of claim 1, or which has homology to the DNA of claim 1 to such an extent that homologous

recombination results in disruption of said DNA, thereby suppressing expression of the gene.” Clearly, since this phrase is written in the alternative, a gene having the sequence of SEQ ID NO: 1 is encompassed, OR a gene which is disrupted due to homologous recombination, and that disruption must be to an extent such that expression is suppressed, that is, a significant disruption. Both of these embodiments were examined in the first Office Action mailed on 06 October 2006. In fact, the Examiner made a rejection under 35 U.S.C. 112, 2nd paragraph, stating that “the embodiment being claimed would require the gene encoding SEQ ID NO: 2 to be disrupted in order to disrupt polysaccharide production.” (see Office Action, page 3). Granted, the Examiner was objecting to the language being somewhat confusing, and that confusion was addressed in the amendment of 08 January 2007, and is therefore, fully responsive.

More importantly, an Election by Original Presentation cannot be instituted since there was never any restriction between the disrupted and undisrupted form of the gene in the original restriction requirement mailed 08 August 2006. Therefore, the Examiner’s statement that Applicants originally elected the undisrupted form of the gene is flatly wrong. Applicants elected the group of Claims 7-8, which encompassed both forms of the gene, as explained above. Both forms of the gene were examined in the First Office Action. Applicant’s amendment filed 08 January 2007 merely clarifies the language of the claim to specify only the disrupted form of the gene (Applicant’s preferred embodiment). Applicants amendment is proper and fully responsive to the first Office Action.

The language used in the Notice, making reference to “the invention of the amended claims is independent from the originally elected invention”, does not properly set forth the basis for a new restriction requirement. Without going into the numerous requirements for such a restriction requirement, it suffices to note that the Notice includes no showings, and therefore none of the showings required to issue a proper “independent and distinct” restriction requirement. Applicant has therefore been denied a full and fair opportunity to assess and respond to the restriction requirement, has been denied a full examination on the merits, and the restriction requirement is *per se* improper. 35 U.S.C. § 132; 37 C.F.R. § 1.104; M.P.E.P. §§ 700 *et seq.*, 800 *et seq.*

Therefore, the Notice’s unsupported restriction requirement fails to lay out and

establish a proper *prima facie* case of distinctness and independence between the two embodiments, and the two embodiments are, in fact, not restrictable. Accordingly, the Notice was in error, and withdrawal of its requirements, express or implied, is earnestly solicited.

Conclusion

Applicant respectfully submits that the present patent application is in condition for allowance. An early indication of the allowability of this patent application is therefore respectfully solicited.

If Examiner Gangle believes that a telephone conference with the undersigned would expedite passage of this patent application to issue, he is invited to call on the number below.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. If, however, additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and the Commissioner is hereby authorized to charge fees necessitated by this paper, and to credit all refunds and overpayments, to our Deposit Account 50-2821.

Respectfully submitted,



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